

REMARKS

Claims 1-24 are all the claims pending in the application. Claims 1, 8, 9, 21, and 24 are currently amended. Claims 14-20 have been cancelled without prejudice. Claims 25 and 26 are newly submitted. Support for the amendments and new claims may be found in the specification as originally submitted.

Claims 1, 3-9, and 11-19, 21, and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Skelley (U.S. 6,795,638) in view of newly cited Middleton (U.S. Pub. 2002/0118300). Claims 2, 10, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Skelley in view of Middleton and Escobar (U.S. 5,659,793). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Rejection under 35 USC 103(a) as being unpatentable over Skelley in view of newly cited Middleton

Claims 1, 3-9, and 11-19, 21, and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Skelley in view of newly cited Middleton. Claims 14-19 have been cancelled, therefore, the rejection is moot.

As amended, claim 1 recites a method for “editing digital broadcasting material in a digital broadcast receiver comprising a recording medium” by “clipping segments from the digital broadcasting material consisting of program segments and being recorded in the recording medium in a stream type.”

Col. 5 lines 51-55 of Skelley disclose that “Upon completion of the operator's selection of clips and events (by monitoring video cassette tape 140, the live performance or a broadcast of

the performance), the event database for the performance is created.” (Emphasis added). Col. 6 lines 21-34 of Skelley disclose “a live performance, or a source recording of a live performance, is viewed by an operator, and, using system 101, the selected events of the performance are identified and characterized. In step 230, the database of events, and the clips on the source recording, are reviewed, edited and sorted into a preferred sequence. In doing so, the operator may modify the length of each clip and add additional information for the corresponding event into the event database. In step 240, the selected sequence of clips, and selected information from the event database associated with the clips, are recorded onto the target recording.” (Emphasis added).

Applicant submits that the passages discussed above explicitly state that an operator selects clips from a video cassette tape, a live performance, or a broadcast of a performance. The clips selected by the operator are then recorded onto the target recording. Applicant submits that selecting clips from a video cassette tape, live performance, or a broadcast of a performance and then recording the clips onto a target recording is patently distinct from “editing digital broadcasting material in a digital broadcast receiver comprising a recording medium” by “clipping segments from the digital broadcasting material consisting of program segments and being recorded in the recording medium in a stream type,” as recited in amended claim 1. Skelley discloses a method of recording from one medium to a different target medium. Recording from one medium to a different target medium is not the same as viewing a broadcast recorded on a recording medium and recording the selected clips in the same recording medium as recited in amended claim 1. Therefore, Skelley cannot teach or suggest a method of “editing a digital broadcasting material in a digital broadcast receiver comprising a recording medium,” by “clipping segments from the digital broadcasting material consisting of program segments and being recorded in the recording medium in a stream type,” as recited in amended claim 1.

Furthermore, as amended, claim 1 recites selecting some of the recorded programs, and merging the selected programs into a new program in the recording medium using start points and end points. As mentioned above, Skelley discloses recording from one medium to a different target medium. However, claim 1 recites that a program recorded on the recording medium is merged into a new program in “the recording medium using start points and end points.” As such,

Skelly also fails to teach or suggest “selecting some of the recorded programs, and merging the selected programs into a new program in the recording medium using start points and end points,” as recited in amended claim 1.

Additionally, page 5 of the Office Action states that “in the same field of endeavor Middleton discloses a method of viewing a sequence of media clips. Middleton discloses creating a new programme from the clips stored in the memory (see page 1 paragraphs 0006-0007). Therefore in light of the teaching in Middleton it is obvious to one of ordinary skill in the art to modify Skelly by further creating a new program from the recorded clips in order to playback the programme of clips without discontinuities.” Applicant respectfully disagrees.

Paragraph 0023 of Middleton discloses that “the program of the present invention typically operates in one of the many available internet browsers loaded onto a local machine connected to a computer network. This network may be a simple LAN, an intranetwork, a WAN or more generally the internet as a whole as this provides the local user with access to a vast number of media clips.”

Applicant respectfully submits that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings.” In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983). Further, it is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Since obviousness may not be established by hindsight reconstruction or conjecture, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof pursuant to MPEP §2144.03.²

It is respectfully submitted that the cited prior art references cannot be combined to teach the claimed invention. Further, even if one is modified in accordance to the teaching of the other, the resultant modification would be an impractical or inoperable combination. For example, Middleton is intended for use on an internet browser on a machine connected to a computer network where the files are stored. On the other hand, Skelley is intended for use on a program which is independent of an internet browser, for files stored on a local machine.

Applicant submits that there is no indication in the Office Action, how such combination is possible, as the two systems are independently complex and cannot be easily modified to work with each other. As such, no portions of the cited references provide a suggestion or motivation for combining the references in a manner that would make the invention as recited in claims 1, 3-9, and 11-19, 21, and 23-24 obvious. Therefore, it is respectfully submitted that the combination of Skelley and Middleton is improper.

For the above reasons, the invention as recited in the amended claim 1 is distinguishable over the references cited by the Examiner. Independent claims 8, 21, and 24 recite elements similar to independent claim 1. Specifically, claims 8, 21, and 24 recite “recording” and editing by “clipping” and “merging” the digital signal in the same storage medium. Therefore claims 1 8, 14, 21, and 24 should be in condition for allowance. Claims 3-7, and 9-13, respectively depend on claims 1, 8, and 21, and should also be in condition for allowance by the virtue of their dependence on an allowable base claim.

¹ *ACSI Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)

² “The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner.”

Finally, newly submitted claims 25 and 26 also recite elements similar to claim 1. Specifically claims 25 and 26 recites “storing” and “editing” the digital signal in the same “storage medium.” Therefore, claims 25 and 26 would be allowable over the cited references.

Rejection under 35 U.S.C. §103(a) as being unpatentable over Skelley in view of Middleton and Escobar

Claims 2, 10, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Skelley in view of Middleton and Escobar. Claim 20 has been cancelled, therefore, the rejection is moot.

Applicant has demonstrated above that Skelley does not teach or suggest various features recited in claims 1 and 8. Applicant has further demonstrated that there is no motivation to combine Middleton and Skelley. Applicant further submits that Escobar does not supply any of the deficiencies of Skelley with respect to “editing digital broadcasting material in a digital broadcast receiver comprising a recording medium,” by “clipping segments from the digital broadcasting material consisting of program segments and being recorded in the recording medium in a stream type,” as recited in amended claim 1. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Skelley in view of Middleton and Escobar in the manner asserted, claim 2 and 10 should be allowable at least by virtue of its dependency upon allowable independent claims 1 and 8.

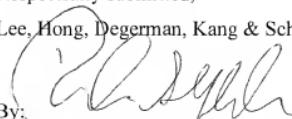
CONCLUSION

In light of the above remarks, Applicant submits that the present Response places all claims of the present application in condition for allowance. Reconsideration of the application is requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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